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EXAMINER

VU, THONG H

ART UNIT PAPER NUMBER

2142

DATE MAILED: 03/02/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

DM

# Office Action Summary

Application No.

09/725,719

Applicant(s)

MALIK, DALE W.

Examiner

Thong H Vu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. Claims 1-19 are pending.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2,4-13,15-17 and 19 are rejected under 35 U.S.C. § 102(e) as being anticipated by Pollack [6,505,236 B1].

3. As per claim 1, Pollack discloses a method of storing an e-mail communication containing an attachment file received in an e-mail server [Pollack, a network-based mail attachment storage system, abstract], comprising the steps of:

- (a) searching a database of attachment files (i.e.: RAID array) previously stored in the email server for a copy of the attachment file from the received e-mail communication [Pollack, attachment comparator, col 6 lines 33-65]; and if a copy of the attachment file is located in the e-mail server,

- (b) removing the attachment file from the e-mail communication [Pollack, detached attachment, col 6 lines 33-65]; and

- (c) creating a link from the e-mail communication to the previously stored

attachment file in the database [Pollack, generating a handle corresponding to the specific address and specific name of the attachment location, col 7 lines 1-10].

4. As per claim 2, Pollack discloses if a copy of the attachment file is not located in the e-mail server, (d) separating the attachment file from the e-mail communication and separately storing the attachment file in the database [Pollack, detached attachment, col 6 lines 33-65]; and (e) creating a link from the e-mail communication to the corresponding attachment file stored in the database [Pollack, generating a handle corresponding to the specific address and specific name of the attachment location, col 7 lines 1-10].

5. As per claim 4, Pollack discloses the database of attachment files is searched by performing a checksum against the attachment file of the received e-mail communication [Pollack, attachment comparator, col 6 lines 33-65].

As per claim 5, Pollack discloses the database of attachment files is searched by comparing properties associated with the attachment files with corresponding properties associated with the attachment file of the received e-mail communication [Pollack, attachment comparator, col 6 lines 33-65].

6. As per claims 6,9 Pollack discloses (c) deleting the link from e-mail communication to the attachment file in response to a delete request; and (d) deleting

the corresponding attachment file when there are no links remaining to the attachment file [Pollack, redundancy deleter, col 6 lines 33-65].

7. As per claim 7, Pollack discloses a method of storing attachment files to e-mail communications received in an e-mail server, comprising the steps of-

(a) extracting header information from the e-mail communications and storing the e-mail header information in a mail store [Pollack, extract anything, col 4 line 40-col 5 line 15];

(b) extracting header information from the attachment file to be stored [Pollack, extract anything, col 4 line 40-col 5 line 15];

(c) comparing the extracted attachment file header information with header information from attachment files previously stored in the mail store to determine whether the attachment files received with the e-mail communications are duplicates of previously stored files [Pollack, attachment comparator, col 6 lines 33-65]; and

(d) if an attachment file is a duplicate, storing a link in the mail store between the e-mail header information and the previously stored attachment file [Pollack, storing the attachment file at a specific address under a specific name, col 7 lines 1-10].

8. As per claim 8, Pollack discloses (e) if an attachment file is not a duplicate of a previously stored attachment file, storing the attachment file in the mail store and storing a link in the mail store between the e-mail header information and the attachment file to the received e-mail communication [Pollack, attachment retriever, col 5 lines 50-67].

9. As per claim 10, Pollack discloses e-mail messages in the e-mail communications are stored with the corresponding e-mail header information in the mail store [Pollack, header, col 4 line 40-col 5 line 15].

10. As per claim 11, Pollack discloses the header information extracted from the attachment files includes a designation of file type [Pollack, header field, col 4 line 40-col 5 line 35].

11. As per claim 12, Pollack discloses the step of comparing extracted attachment file header information is performed by searching the previously stored attachment files that are designated as the same file type as the attachment file to the received e mail communication [Pollack, col 6 lines 33-65].

12. As per claim 13, Pollack discloses the header information extracted from the attachment files further includes at least one of: size, creation date, revision date, author, software type, version, and revision number as inherent feature of header field.

13. As per claim 15, Pollack discloses an e-mail communications server comprising:

(a) an MTA server for receiving e-mail communications from an external network [Beyda, a local router/server 12, Fig 1];

(b) a mail store for storing e-mail communications received by the MTA server [Pollack, network servers, col 7 lines 48-51];

(c) a POP server for downloading e-mail communications from the mail store to client computers through an internal network [Pollack, Internet, col 4 lines 3-14]; and

(d) e-mail attachment file checking software for determining whether attachment files in received e-mail communications are duplicates of attachment files in the mail store, wherein the mail store removes duplicate attachment files from e-mail communications and creates links from received e-mail communications to the corresponding attachment files in the mail store Pollack, col 6 line 33-col 7 line 10].

14. As per claim 16, Pollack discloses the mail store further comprises a database for storing the links from received e-mail communications to the attachment files [Pollack, RAID array, col 4 lines 25-39].

15. As per claim 17, Pollack discloses a first attachment storage database for storing attachment files that are each associated with a single e-mail communication, and a second attachment storage database for storing attachment files that are each associated with a plurality of e-mail communications as a design choice of database or RAID array.

16. As per claim 19, Pollack discloses the e-mail attachment file checking software extracts properties associated with the attachment files in the received e-mail

communications, and searches the mail store for attachment files having the same properties [Pollack, a variety of available formats, col 5 lines 27-36].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 3,14,18 are rejected under 35 U.S.C. § 103 as being unpatentable over Pollack [6,505,236 B1] in view of Beyda et al [Beyda, 6,275,850 B1]

18. As per claim 3, Pollack does not disclose detecting the size of the attachment file associated with the received e mail communication, wherein the steps of searching the database, removing the attachment file from the e-mail communication; and creating a link from the e-mail communication are only performed if the attachment file is greater than a predetermined size.

A skilled artisan would have motivation to modify the attachment comparator and found Beyda teaching. Beyda discloses a method for management of message attachments based on the maximum size of attached file [Beyda col 4 lines 36-44;col 5 lines 22-58; col 6 lines 30-62]

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the technique of automatically download the attachment based on the threshold size as taught by Beyda into the Pollack's



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apparatus in order to utilize the attachment comparator. Doing so would provide a dynamic and simple process to manage the attached file of email over Internet.

19. As per claim 14, Pollack-Beyda disclose the step of comparing extracted attachment file header information is performed only when the size of the attachment file is greater than a predetermined size [Beyda col 4 lines 36-44; col 5 lines 22-58; col 6 lines 30-62].

20. As per claim 18, Pollack-Beyda disclose the e-mail attachment file checking software only checks attachment files that are greater than a predetermined size [Beyda col 4 lines 36-44; col 5 lines 22-58; col 6 lines 30-62].

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (703)-305-4643. The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Jack Harvey*, can be reached at (703) 305-9705.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9700.

Any response to this action should be mailed to: Commissioner of Patent and Trademarks, Washington, D.C. 20231 or faxed to :

After Final (703) 746-7238

Official: (703) 746-7239

Non-Official (703) 746-7240

Hand-delivered responses should be brought to Crystal Park 11,2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

**Thong Vu**  
**Patent Examiner**  
**Art Unit 2142**

